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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Bruno Teychene

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07/19/2010

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EXAMINER

BACHMAN, LINDSEY MICHELE

ART UNIT

PAPER NUMBER

3734

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/532,569	<b>Applicant(s)</b> TEYCHENE, BRUNO	
	<b>Examiner</b> Lindsey Bachman	<b>Art Unit</b> 3734	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 June 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                     |                                                                   |
|-------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                         | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4 June 2010 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21, 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 21 and 22 states that the absorbent material has a thickness smaller than the female tag component and the hollow head of the female tag component, respectively. The drawings that Applicant cited as containing support for this feature (Figures 2, 9 and 12) do not show a cross-section and do not show the thickness of the

Art Unit: 3734

material, and therefore cannot show the thickness of absorbent material relative to the female tag component and the hollow head. The cited paragraphs ([0047], [0055-0056], [0061]) are all directed towards attaching the absorbent material to the attachment.

### ***Response to Arguments***

Applicant's arguments filed 4 June 2010 have been fully considered but they are not persuasive.

Applicant argues that the absorbent material disclosed by Howe'781 is saturated in insecticide or other liquid or solid before use and therefore is not intended for use in collecting a sample from the animal. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The felt disc/sponge 33 disclosed by Howe'781 is capable of absorbing a sample, and therefore reads on the claimed invention.

Applicant argues that the sample container/attachment 29 is destroyed during removal from the ear tag and is therefore not suitable in use for collecting a sample. However, the sample is contained in the absorbent material. As such, a sample is still capable of being collected from the Howe'781 device. Applicant further argues that the container 29 is not separated from the ear tag by operation of the applicator tool, when

Art Unit: 3734

the ear tag is applied to the animal. However, the language of the claim is such that the applicator tool is not being claimed as part of the invention (emphasis added):

“a) the male tag component includes a punch that, in use, perforates an animal's ear and penetrates into a hollow head of the female tag component under the action of an applicator tool, having jaws;”

And also:

“c) the sampling device further includes an attachment for fixing the sampling device to one of the jaws of the applicator tool whereupon, during use opening of the jaws and/or removal of the applicator tool from the animal's ear separates the sampling device from the female tag component.”

Nothing in the above passage, taken from Claim 12, positively recites an applicator tool. All recitations discussing the applicator tool are directed to the intended use of the invention. As such, an applicator tool could be designed to work with the Howe'781 invention as described in the claim. Further, the preamble of the claim indicates that the invention is drawn to an ear tag, not an ear tag and a delivery device. All limitations discussing the applicator tool are drawn towards the intended use of the device which, as noted above, must result in a structural difference between the prior art and the claimed invention.

Applicant argues that the claimed invention requires that the absorbent material/sampling device is attached to the female ear tag component during application of the ear tag, while Howe'781's sampling device is applied to an ear tag already on the ear. Again this is an intended use argument. Howe'781's sampling device is capable of being attached while the female ear tag component is applied since they are intended to be attached to one another. Applicant argues that the punch doesn't penetrate the absorbent material as claimed. However, as seen in Figure 7, the punch is capable of penetrating the absorbent material. The punch is not penetrating the absorbent material

Art Unit: 3734

in Figure 7 due to the thickness of the ear tissue. If the device were applied to thinner tissue, the punch would penetrate and pass through the absorbent material.

Applicant argues that the Howe'681 does not disclose an attachment for fixing the sampling device to one of the jaws of the applicator tool. As discussed above, the applicator tool is not being claimed as part of the invention. In light of this, Examiner maintains that, as discussed in the previous Office Action, element 29 is capable interacting with applicator tool jaws to aid in applying the ear tag and remove the sampling device.

Regarding Claim 14, Applicant argues that the absorbent material 33 is not capable of serving as a sampling strip. Examiner does not understand how Howe'781's absorbent material is *not* capable of serving as a sampling strip. Element 33 is an absorbent material, therefore it can absorb body fluids for the purpose of taking a sample. The fact that Howe'781 doesn't explicitly describe this doesn't preclude element 33 from absorbing body fluids.

Regarding Claim 19, Applicant argues that the sampling device does not contain a slit over the opening of the hollow head of the female tag component. However, Howe'781 clearly shows a slit (formed with element 14) over the opening of the female tag component (see Figure 7, for example).

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claim 12-19 and 23 are rejected under 35 U.S.C. 102(b) as anticipated by Howe et al. (US Patent 4,694,781).**

Claim 12: Howe'781 discloses a device that contains a male tag component (16, 17) with a punch (18) that is capable of penetrating an animal's ear and penetrating into a hollow head (12) of a female tag component (10). The female tag component (10) contains a sampling device (33) that is capable of sampling biological material from the ear of the animal. The sampling device extends outwardly from element 12 of the female tag component. The sampling device is separable from the female tag component (see Figure 5). The sampling device also contains an attachment (29) that can be used to attach to an applicator tool.

Claim 13: Howe'781 discloses that the sampling device (33) is an absorbent material. The absorbent material is perpendicular to the male punch because it extends radially from the hollow head (12) (see Figure 7).

Claim 14, 15, 16: The absorbent material (33) is capable of serving as a sampling strip. One end is fixed to the attachment (bottom portion placed within attachment 29; see Figure 7) while the other end is perpendicular to the direction of the punch through the animals ear (top end extends radially from the punch (see Figure 7) attached to the hollow head (12, 13) (Figure 7).

Claim 17: The attachment (29) and sampling device (33) are located over an opening in the hollow head (12) of the female tag component (Figure 7).

Claim 18: The attachment (29) is fixed to the periphery of the hollow head (12) (see Figure 7).

Claim 19: The attachment and sampling device are located over an opening of the hollow head (see Figure 7).

Claim 23: The absorbent material (33) is adhered to the attachment (29) (see Figure 7).

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Howe'781, as applied to Claim 12, in view of Brem (US Patent 6,509,187).**

Claim 20: The male component contains a panel (16) and the female component contains a panel (10). Both components are capable of being marked with identical symbols. Howe'781 does not teach marking all the components with a symbol/lable.

Brem'187 teaches a device for tagging an animal and collecting a sample that contains a male tag component (10), a female tag component (11) and a sample collection element (Figure 1) attached to a tongue (9). Brem'187 teaches that all three components can be labeled with a symbol for the purpose of identifying which animal the tag corresponds (column 3, lines 15-26). It would have been obvious to one of ordinary skill in the art to modify the device of Howe'781 with the teachings of Brem'187 so that it too has this advantage.

**Claims 21, 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Howe'781.**

Howe'781 does not show that the thickness of the absorbent material is thinner than the hollow head of the female tag component. However, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the absorbent material thinner than the hollow head of the female tag component because Applicant has not disclosed that modifying the thickness of the absorbable material apart provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected the thickness of the Howe'781's absorbable material, and applicant's invention, to perform equally well with either the thickness taught by Howe'781 or the claimed thickness because both thicknesses would perform the same function of absorbing body fluid.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lindsey Bachman whose telephone number is (571)272-6208. The examiner can normally be reached on Monday to Friday, 8:00 am to 5:00 pm, off alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3734

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. B./  
Examiner, Art Unit

/TODD E. MANAHAN/

Supervisory Patent Examiner, Art Unit 3734